



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,275	07/08/2003	Dennis E.J.G.J. Dolmans	00786-546001 / MGH 2055	8209
26161	7590	09/28/2005	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			ROYDS, LESLIE A	
			ART UNIT	PAPER NUMBER
			1614	

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/615,275	<b>Applicant(s)</b> DOLMANS ET AL.	
	<b>Examiner</b> Leslie A. Royds	<b>Art Unit</b> 1614	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

*JSO*

### **DETAILED ACTION**

**Claims 1-22 are presented for examination.**

#### ***Requirement for Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 5, 7 and 17-18, drawn to a method for administering photodynamic therapy (PDT) to a target tissue in a subject, wherein the target tissue is tumor tissue, classified in class 514, subclass 185, for example, depending on the photosensitizing compound used.
- II. Claims 19-20, drawn to a method for administering photodynamic therapy (PDT) to a target tissue in a subject, wherein the target tissue is eye tissue, classified in class 514, subclass 185, for example, depending on the photosensitizing compound used.
- III. Claims 21-22, drawn to a method for administering photodynamic therapy (PDT) to a target tissue in a subject, wherein the target tissue is skin tissue, classified in class 514, subclass 185, for example, depending on the photosensitizing compound used.

Claims 1-4, 6 and 8-16 link Inventions I through III. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1-4, 6 and 8-16. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all

Art Unit: 1614

the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP §804.01.

The inventions are distinct, each from the other, for the following reasons:

Inventions I through III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the method encompassed by Group I has a different mode of operation, different function and a different effect than that of Groups II or III. Similarly, Group II has a different mode of operation, different function or different effect than that of Groups I or III and Group III has a different mode of operation, different function or different effect than that of Groups I or II. For example, the methods of Groups I through III are each practiced in distinctly different tissue types and for the treatment of distinctly different disorders, such that the administration of PDT to tumor tissue for the amelioration of cancer would not anticipate or render obvious the administration of PDT to eye tissue for the amelioration of macular degeneration. Furthermore, performance of a comprehensive search encompassing each of the three distinct methods of administering PDT to tumor, eye or skin tissue would be a undue burden on the Examiner. Each of the treatment objectives (i.e., treating tumor tissue for cancer, treating eye tissue for macular degeneration or choroidal neovascularization, or treating skin tissue for psoriasis or scleroderma)

Art Unit: 1614

has a different and distinct etiology and pathophysiological manifestations, such that each is differently treated. Such is sufficient to indicate that the administration of PDT for each diseased tissue type is differently searched in the patent and non-patent literature and that the search for one disease will not necessarily result in a comprehensive search of any one or more of the other diseases listed. Notwithstanding that Applicant may have established an underlying commonality for the claimed diseases, it remains that each of the diseases and, thus, the tissue associated with such a disease, are recognized in the art as being clinically and pathophysiologically distinct from one another. In light of such, it is clear that each of the above-identified groups is recognized in the art as being clinically and pathophysiologically distinct from one another and, thus, each group is fully capable of supporting separate patents.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Claims 13-15 are generic to a plurality of disclosed patentably distinct species comprising numerous photosensitizing compounds. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should Applicant traverse on the ground that the species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone call was made to J. Peter Fasse at the office of Fish and Richardson, P.C. on Friday, September 23, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

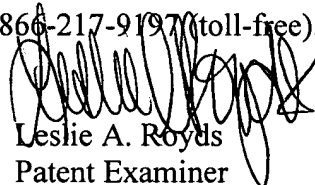
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Leslie A. Royds whose telephone number is (571)-272-6096. The Examiner can normally be reached on Monday-Friday (8:30 AM-6:00 PM), alternate Fridays off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Christopher Low can be reached on (571)-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Leslie A. Royds  
Patent Examiner  
Art Unit 1614

September 23, 2005



CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600